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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------|------------------|
| 10/601,404 | 06/23/2003 | Larry Randall Daudet | 98356CONCONCON | 7735 |
| 26285 | 7590 | 12/29/2004 | EXAMINER | |
| KIRKPATRICK & LOCKHART LLP 535 SMITHFIELD STREET PITTSBURGH, PA 15222 | | | GREEN, CHRISTY MARIE | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3635 | |

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

| | | |
|-----------------|---------------|--|
| Application No. | Applicant(s) | |
| 10/601,404 | DAUDET ET AL. | |
| Examiner | Art Unit | |
| Christy M Green | 3635 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 September 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-8 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/10/04
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

This is a second office action for serial number 10/601404, entitled Joist Support Apparatus, filed on June 23, 2003.

Response to Amendment

In response to the examiner's office action dated June 10, 2004, the applicant has made amendments to the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 8 stand rejected under 35 U.S.C. 102(b) as being anticipated by Chalmers et al., US patent # 4,288,958.

Chalmers discloses the claimed invention an apparatus comprising a joist rim (12) having a web (26) and first and second rim legs (24) extending substantially perpendicularly from the web (figure 2), at least one opening (28) through the web (26), a joist attachment tab (14) integrally formed in the web (column 4, lines 64-65) adjacent each the opening (28 - figure 2), each of the attachment tabs extending from the web at an angle relative to the web (column 5, lines 39-49), and at least one reinforcing rib (32) corresponding to each of the tab (14) and provided in each of the web adjacent the corresponding tab (figure 2); the angle between each attachment tab and the web is substantially ninety degrees (shown in figure 2); each reinforcing rib (32) is parallel to

the adjacent tab (14); the reinforcing ribs comprise indentations (at 32) that are embossed on a surface of the web (26); and, the web (26) has a plurality of fastener holes (28) therethrough.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Chalmers in view of Liss, US Patent # 5,956,916.

Chalmers discloses the claimed invention as stated above in claim 1, except for the joist attachment tabs has a plurality of fastener holes. Liss teaches that it is known in the art to provide the joist attachment tab (6) with a plurality of fastener holes (13) therethrough. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the plurality of fastener holes in the attachment tab as taught by Liss with the attachment tab of Chalmers in order to provide a further securing means to attach a member to the tab by the use of screws (column 3, line 67 and column 4, lines 1-2).

Claim 6 and 7 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Chalmers in view of Kostecky, US Patent # 3,845,601.

Chalmers discloses the claimed invention as stated above in claim 1, except for the first leg has a plurality of fastener holes therethrough. Kostecky teaches that it is known in the art to provide the first leg (4) has a plurality of fastener holes (12) therethrough. It would have been obvious for one having ordinary skill in the art at the time the invention was made to provide plurality of fastener holes in the first leg as taught by Kostecky first leg of Holmes in order to assure the apparatus will be in proper position if applied to the legs of the web "24" and will remain tightly locked to the panel or track (column 2, lines 65-67).

Response to Arguments

Applicant's arguments filed September 22, 2004 have been fully considered but they are not persuasive.

In regards to the applicants arguments that claim 1 is directed to "[a]n apparatus for supporting a plurality of joist, the apparatus comprising:..." and that the word joist does not appear anywhere in the Chalmers et al. or Kostecky patent, the examiner recognizes the argument, however, the functional recitation *for supporting a plurality of joist* has not been given much patentable weight because it does not positively claiming the joist in conjunction with the apparatus and it is in narrative form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth in USC 112, 6th paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language, or the joist should be positively claimed in combination or in conjunction with the apparatus itself.

In response to applicant's argument that the fastener holes of Chalmers would provide passages through the panels for water to infiltrate behind the panels, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

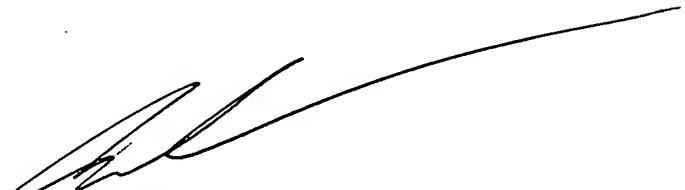
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christy M Green whose telephone number is 703-308-9693. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 703-308-0839. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

①.
Cg
December 21, 2004



Carl D. Friedman
Supervisory Patent Examiner
Group 3600